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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,946	09/30/2003	Kristin L. Jambor	ENDS083-515149	7866

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EXAMINER

COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/676,946

Applicant(s)

JAMBOR ET AL.

Examiner

David Comstock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-22 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 and 23-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8-12,21 and 22 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election **without** traverse of the species of group I (Fig. 3), claims 1, 3-12, 21 and 22, in the reply filed on 07 November 2006 is acknowledged. Claims 13-20 and 23-28 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-5, 9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,157,713 to Clarey.

Clarey discloses a band comprising: a tension carrying belt (10); a balloon (24) attached to said tension carrying belt, said balloon comprising a plurality of partitions (22) defining a plurality of inner chambers (26); and a fluid supply tube (50,52) in fluid communication with said balloon and attached to said

tension carrying belt; wherein said fluid supply tube further comprises a plurality of inlets wherein each of said plurality of inlets is in fluid communication with a corresponding one of said plurality of inner chambers of said balloon and said fluid supply tube inlets at each end of the partition; plurality of check valves each of which is located within one of said plurality of inlets (Column 3, lines 30-42); wherein each of said plurality of check valves comprises a one-way check valve; wherein each of said plurality of check valves comprises a two-way check valve; wherein said tension carrying belt further comprises a latching mechanism (34, 36). The valves are considered to be check valves since the valves prevent backflow of air out of the device and allow movement of air in and out when it is required. The compartments (26) may also be interpreted as a plurality of balloons, since the partitions separate the interior of the balloon that is attached to the band. In addition the partitions (22, may also be interpreted as reinforcing structure.

Regarding the preamble "gastric", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

4. Claims 1 and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by PG-PUB 2005/0192531 to Birk.

Birk discloses a gastric band comprising: a tension carrying belt(10); a balloon attached to said tension carrying belt (6), said balloon comprising a

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plurality of partitions defining a plurality of inner chambers (FIG. 4); and a fluid supply tube in fluid communication with said balloon and attached to said tension carrying belt (paragraph 0030); wherein said latching mechanism comprises one or more sutures (paragraph 0006); wherein the device has a length between 8 and 15 cm (paragraph 0008).

Birk discloses a gastric band comprising: a tension carrying belt (10); a plurality of balloons (6) wherein said plurality of balloons is attached to said tension carrying belt (FIG. 4); and a fluid supply tube comprising a plurality of inlets (paragraph 0006) wherein said fluid supply tube is attached to said tension carrying belt such that said plurality of inlets of said fluid supply tube provide fluid communication between each of said plurality of balloons and said fluid supply tube (paragraph 0006).

Birk discloses a gastric band comprising: a tension carrying belt (10) having a top portion; a balloon having an interior surface, said balloon further comprising one or more reinforced sections (7) disposed along the length of said interior surface of said balloon (paragraph 0033) said balloon being attached to said tension carrying belt (paragraph 0031); and a fluid supply tube wherein said fluid supply tube provides fluid communication between said balloon and said fluid supply tube (paragraph 0030); wherein upon being placed in an encircling position around a stomach, each of said reinforced sections contacts said top portion of said tension carrying belt dividing said balloon into at least two chambers (FIG. 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,157,713 to Clarey.

Clarey discloses the claimed invention except for explicitly disclosing the limitations pertaining to the size of the inlets. However, it would have been obvious to have formed the inlets of an appropriate size since it has been held to be within the level of ordinary skill in the art to determine size. *In re Rose*, 105 USPQ 237 (CCPA 1955).

6. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over PG-PUB 2005/0192531 to Birk.

Birk likewise discloses the claimed invention except for explicitly disclosing the limitations pertaining to the size of the inlets. However, it would have been obvious to have formed the inlets of an appropriate size since it has been held to be within the level of ordinary skill in the art to determine size. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Allowable Subject Matter

7. Claims 6 and 7, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments have been considered but they are not persuasive. In response to Applicant's argument and claim amendments pertaining to the inlets and valves, it is noted that the supply portion of the device corresponding to each chamber region can be considered to be its respective inlet and/or valve. Likewise, the wall portions of each chamber region can constitute the "separate skin" regions.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER